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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,970	06/30/2000	Kia Silverbrook	NPA015US	1454
24011	7590	12/08/2003	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			BACKER, FIRMIN	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/608,970

Applicant(s)

SILVERBROOK ET AL.

Examiner

Firmin Backer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

This is in response to an amendment file on October 26<sup>th</sup>, 2003 for letter for patent filed on June 30<sup>th</sup>, 2000. In the amendment, claims 1 and 6 have been amended, claims 5 and 10 have been canceled, and no claim has been added. Claims 1-4 and 6-9 remain pending in the letter.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danielle (U.S. Patent No. 5,444,779) in view of Fox et al (U.S. PG Pub 2003/0069873).
3. As per claims 1 and 6, Danielle teaches a method and system of collecting a copyright fee (*electronic copyright royalty accounting system*) relating to a document when a user (*user*) obtains via coded data disposed on a surface (*printed copyright document*) (*see abstract, fig 2*), the document, the method including in a computer system (*database type system, 54*) recording a copyright owner relating to a portion of the document (*see column 8 lines 22-39*), receiving (*sense*) from a sensing device (*glyphs detector, 30*), indicating data indicative of a request for the document (*document to be printed*), the sensing device, when placed in an operative position relative to the surface, generating the indicating data using one of the coded data (*see fig 3, 4*,

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*column 8 line 40-9 line 26*), determining the fee from the ownership and debiting a user account associated with the user in the amount of the fee (*see column 9 line 39-10 line 35 11 line 45-12 line 39*) Danielle further teach an inventive concept system wherein the coded data is indicative of a region of the surface of the reference point of the region and a position of the sensing device (*see column 5 line 7-47*). Danielle fails to teach an inventive concept of identifying in the database identifying the request document, retrieving the document from the document database and providing the document to the user. However, Fox et al teach an inventive concept inventive concept of identifying in the database identifying the request document, retrieving the document from the document database and providing the document to the user (*see paragraph 0014, 0017, 0039-0041*). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Danielle's inventive concept to include Fox et al's inventive concept of identifying in the copyright database and from the indicating data, the copyright owner relating to the document because this would have provided a method for quickly and efficiently search the document data base and present the result in a meaningful manner.

4. As per claims 2 and 7, Danielle teaches a method and system further comprising crediting the owner account of the fee (*see fig 3, 4, column 8 line 40-9 line 26*).

5. As per claims 3 and 8, Danielle teaches a method and system further printing the document (*see fig 3, 4, column 8 line 40-9 line 26*).

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6. As per claims 4 and 9, Danielle teaches a method and system further receiving device identity of the user and identifying the user account (*see column 8 lines 22-39*).

***Response to Arguments***

7. Applicant's arguments filed October 26<sup>th</sup>, 2003 have been fully considered but they are not persuasive.

a. Applicants amended claims 1 and 6 and introduced the feature “*indicative of a plurality of reference points of the region and the indicative data is indicative of a position of the sensing device relating to the region*” in the canceled claims 5 and 10.

Applicants argue that the prior arts fail to teach the introduced feature in the inventive concept that is “*indicative of a plurality of reference points of the region and the indicative data is indicative of a position of the sensing device relating to the region.*”

Examiner respectfully disagrees with applicant characterization of the prior arts. Danielle, especially, teach an inventive concept wherein a system to account for copyright royalties accrued as a result of printing a copyrighted document on a document printer. The concept including an apparatus, associated with a reprographic device, for tracking the reproduction of at least a portion of a copyrighted document having a visible glyph code on each page represented by the stored *digital signals* so as to determine if a copyright royalty is associated with the reproduced page. The original document having a *printable glyph code on each page and means for sensing the presence of the printable glyph code on at least one page of the original document* (emphasis added) which is

equivalent to the applicant sensing device for sensing position relating to a region.

Danielle further teach that the concept decode the printable code for determining that the document is copyrighted; and means for disabling the reproduction of the document upon a determination that the document is copyrighted (*see column 5 lines 7-47*).

b. It is respectfully submitted that Examiner's rejection has not fully traverse by Applicants' arguments and the claims are not in condition for allowance.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

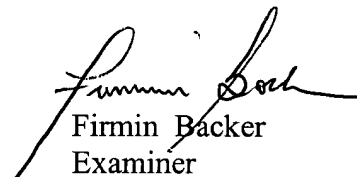
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

  
Firmin Backer  
Examiner  
Art Unit 3621

December 4, 2003